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103 East Neck Road
Huntington, NY 11743

EXAMINER

TORRES, MARCOS L

ART UNIT PAPER NUMBER

2617

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/857,675

Applicant(s)

FISCHER ET AL.

Examiner

Marcos L. Torres

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-49 and 51-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72 is/are allowed.
- 6) ☒ Claim(s) 37-49 and 51-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9-1-06 have been fully considered but they are not persuasive.
2. Regarding applicant argument that Alanara does not disclose a central station of a telecommunication station, to which a short message is transmitted, Alanara discloses a radiotelephone receiving short messages using the short message broadcast channel according to Interim Standard IS-136 (see col. 3, lines 16-51) and also Vanttila discloses a central station of a telecommunication station to which a short message is transmitted (see fig. 2, item 34).
3. Regarding applicant argument that Alanara does not disclose a short message that is addressed to a subscriber of a telecommunication network; Alanara disclose this limitation in col.5, lines 22-38) and Vanttila in col. 3, line 9-21.
4. Regarding applicant argument that Alanara does not disclose notification message which is different from the short message, that limitation is taught by Vanttila in col. 5, lines 13-24.
5. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 2617

6. Regarding applicant argument that Vanttila does not disclose a notification message, the message notifying the user, if he/she want the service is a notification message, see col. 3, lines 9-21.

7. Regarding applicant argument that Vanttila notification message does not have a first data field of the short message transmitted; the claims 37 and 71 does not require transmitting a data field of the short message, only data about the content or makeup of the short message.

8. Regarding applicant argument that Alanara does not disclose any notification message, Alanara does disclose a notification message, however the notification message and the short message are transmitted in the same message (see col. 2, lines 1-8).

9. In response to applicant's arguments that Vanttila does not disclose a notification message that is different from the short message as a data field of the short message; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Please see paragraph 4-8 above. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding applicant argument directed to the combination of the reference in claim 37 and 71, both references are directed to sending and receiving short messages see in Alanara col. 1, lines 14-17 and col. 2, lines 49-55 in Vanttila. Since both reference are analogous it would have been obvious to one of the ordinary skill in the art at the time of

Art Unit: 2617

the invention to combine the references since they are directed to the same field of endeavor. The current rejection in record stands.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2617

13. Claims 37-42, 44-47, 49, 52-62, 66-68 and 70-71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara US005604921A in view of Vanttila (U.S. Patent US005794142A).

As to claim 37-38 and 49, Alanara discloses a method for transmitting short messages in a radio telecommunications network, comprising the steps of sending a notification message from a central station to the addressed to a subscriber of a telecommunications network as a function of a short message transmitted to the telecommunications network for the subscriber (see col. 1, lines 6-17); transmitting to the subscriber with the notification message, data that includes items of information about a content of the short message; and transmitting to the subscriber as the notification message, a first data field of the short message, which includes the data having the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose sending a short message to a central station of a telecommunications network, wherein the notification message is different from the short message. In an analogous art, Vanttila discloses sending a short message to a central station of a telecommunications network (see col. 6, line 13-40); wherein the notification message is different from the short message (see col. 5, lines 13-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for the simple purpose of saving bandwidth.

As to claim 39, Vanttila discloses a method further comprising transmitting to the subscriber the notification message only after a request signal has been output by the subscriber to the telecommunications network (see col. 6, lines 5-35).

As to claim 40, Vanttila discloses a method further comprising providing the first data field of the short message as a text-based data field (see col. 5, lines 16-19).

As to claim 41, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the makeup of the short message about a size of the data fields (see col. 2, lines 4-8).

As to claim 42, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the content of the short message, indications about presence of various data types and the short message in various data fields of the short message (see col. 2, lines 4-9).

As to claim 44, Alanara discloses a method further comprising reading out at the subscriber the items of information about the makeup and/or content of the short message from a notification message received and shown on a display device (see col. 2, lines 15-23).

As to claims 45 and 46, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose the data in menu/directory-controlled fashion, corresponding menu structures being generated at the subscriber as a function of the readout information about the makeup and/or content of the short message. Vanttila disclose the data in menu/directory-controlled fashion, corresponding menu structures being generated at the subscriber as a function of the readout information about the makeup and/or content of the short message (see col. 6, lines 13-20). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for a user-friendly interface.

As to claim 47, Alanara discloses a method further comprising processing the items of information about the content of the short message in a subscriber station of the subscriber (see col. 3, lines 45-52).

As to claim 52, Alanara discloses a method further comprising transmitting the notification message to the subscriber in form of a short message (see col. 1, lines 6-15). Alanara and Vanttila do not specifically disclose transmitting the global system for mobile communications standard. However, OFFICIAL NOTICE IS TAKEN THAT GSM standard is a common and well-known standard. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this standard or any other equivalent standard for the simple purpose of compatibility.

As to claims 53 and 66-68, Vanttila discloses a method further comprising transmitting the short message to the telecommunications network by a sender, which is a mobile sending station (see col. 6, lines 13-15). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of sending a command.

As to claims 54 and 55, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting from the central station to the telecommunications network an acknowledgment message for the sender, once the short message has been received from the central station. However, OFFICIAL NOTICE IS TAKEN THAT the method of sending acknowledgment once the step have been completed is a common and well-known technique. Therefore, it would

Art Unit: 2617

have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of reliability.

As to claim 56 is a combination of limitations of claims 52 and 55. Therefore they are rejected for the same reason of claims 52 and 55.

As to claim 57, Vanttila discloses a method further comprising transmitting the short message from a central station, which is a network operator for a receiver, which is mobile receiver to the telecommunications network (see col. 6, lines 34-35).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique in order to receive messages.

As to claim 58, Vanttila discloses a method further comprising processing by a command message transmitted to the telecommunications network by the subscriber at least one data field of the short message as a function of the content of the command message (see col. 5, lines 25-50; col. 6, lines 25-32).

As to claim 59, Vanttila discloses a method further comprising preparing the command message at the subscriber as a function of at least one user input at an input unit (see col. 6, lines 13-24).

As to claim 60, Vanttila discloses a method further comprising preparing the command message automatically at the subscriber at the function of the items of information about the content of the short message (see col. 6, lines 13-24).

As to claim 61, Vanttila discloses a method further comprising preparing the command message as a function of command criteria that are specified by the subscriber (see col. 6, lines 13-24).

As to claim 62, Vanttila discloses a method further comprising requesting by the subscriber from the telecommunications network at least one data field of the short message by means of a command message embodied as a selection message and transmitted to the telecommunications network; and transmitting the at least one requested data field of the short message to the subscriber (see col. 6, lines 13-40).

As to claim 70, Alanara discloses a notification message in form of a header information; and further comprising generating from indications about the content of at least two data fields of the short message the items of information about the content of the short message; and obtaining the indications from these data fields (see col. 2, lines 1-23). Vanttila discloses a method further comprising transmitting from the central station to the telecommunication network the command message in form of a short message service message (see col. 3, lines 52-55; col. 6, line 13-40) by a global system for mobile communications standard, and the notification message in form of a first item of header information; and further comprising generating from indications about the content of at least two data fields of the short message the items of information about the content of the short message; and obtaining the indications from these data fields. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for the simple purpose of enhanced service.

As to claim 71, Alanara discloses a method for transmitting short messages in a radio telecommunications network, comprising the steps of sending a notification message from a central station to a subscriber of said telecommunications network as a

function of a short message transmitted to the telecommunications network for the subscriber (see col. 1, lines 6-17); transmitting to the subscriber with the notification message, data that includes items of information about a content of the short message; and transmitting to the subscriber as the notification message, a first data field of the short message, which includes the data having the items of information about the content of the short message wherein the notification message is different from the short message (see col. 2, lines 1-8). Alanara does not specifically disclose sending a short message to a central station of a telecommunications network, for the method transmitting to the subscriber the notification message only after a request signal has been output by the subscriber to the telecommunications network. In an analogous art, Vanttila discloses sending a short message to a central station of a telecommunications network (see col. 6, line 13-40); a method further comprising transmitting to the subscriber the notification message only after a request signal has been output by the subscriber to the telecommunications network (see col. 6, lines 5-35). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for the simple purpose of managing bandwidth

14. Claims 43 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila and further in view of Winbladh (U.S. Patent US006205330B1).

As to claim 51, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting to the communication

Art Unit: 2617

network the short message as a message from an electronic mail surface as an Internet E mail message. In an analogous art, Winbladh discloses a method further comprising transmitting to the communication network the short message as a message from an electronic mail surface as an Internet E mail message (see abstract). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the Alanara system for versatility.

As to claim 43, Alanara discloses a method further comprising transmitting to the subscriber the items of information about the content of the short message (see col. 2, lines 1-8). Alanara does not specifically disclose indications about the sender of the data stored in memory of the short message. In an analogous art, Winbladh discloses indications about the sender of the data stored in memory of the short message (see col. 7, lines 6-23). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Alanara message for enhanced convenience.

15. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila and further in view of Söderbacka (U.S. Patent US006665531B1).

As to claim 48, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting the items of information about the content of the short message for processing to an identity module of the subscriber, issued by a service provider. In an analogous art, Söderbacka discloses a method further comprising transmitting the items of information about the content of the

Art Unit: 2617

short message for processing to an identity module of the subscriber, issued by a service provider (see col. 4, line 29 – col. 5, line 14). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced control.

16. Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila (U.S. Patent US005794142A) as applied to claim 58 above, and further in view of Söderbacka.

As to claim 65, Alanara and Vanttila disclose everything claimed as explained above except for a method further comprising transmitting by the subscriber to the telecommunications network a command message embodied as a delete message; and deleting at least one data field of the short message as a function of the delete message. In an analogous art, Söderbacka a method further comprising transmitting by the subscriber to the telecommunications network a command message embodied as a delete message; and deleting at least one data field of the short message as a function of the delete message (see col. 6, lines 10-50). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the Alanara message for enhanced control.

17. Claim 69 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila (U.S. Patent US005794142A) as applied to claim 67 above, and further in view of Proust (U.S. Patent US006216014B1).

As to claim 69, Alanara discloses everything claimed as explained above except for a method further comprising preparing the command message and the notification

Art Unit: 2617

message by an identity module of the subscriber, which pertains to a service provider.

Vanttila discloses a method further comprising preparing a command message, which pertains to a service provider (see col. 6, lines 13-24). In an analogous art, Proust

discloses a method further comprising preparing a notification message by an identity module of the subscriber, which pertains to a service provider (see col. 2, lines 12-17).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for the simple purpose of having enhanced services.

18. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alanara (U.S. Patent US005604921A) in view of Vanttila (U.S. Patent US005794142A) as applied to claim 62 above, and further in view of Hansson (U.S. Patent US006400942B1).

As to claims 63 and 64, Alanara discloses a method further comprising transmitting at least two data fields of the short message sequentially (see col. 2, lines 1-8). Alanara does not specifically disclose that are requested by the subscriber by the selection message, simultaneously transmitted. In an analogous art, Hansson discloses transmitting simultaneously (see col. 1, lines 37-40). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching for bandwidth management purpose.

Allowable Subject Matter

19. Claim 72 is allowed.

20. The following is an examiner's statement of reasons for allowance: A method for transmitting shod messages in a radio telecommunications network, comprising the

Art Unit: 2617

steps of sending a notification message to a subscriber of a telecommunications network as a function of a short message transmitted to the telecommunications network for the subscriber transmitting to the subscriber with the notification message data that includes items of information about a makeup and/or a content of the short message; and transmitting to the subscriber as the notification message, a first data field of the short message, which includes the data having the items of Information about the makeup and/of the content of the short message; transmitting with the notification message to the subscriber a first item of header Information and a message, the first item of header information including at least one item of Information about the content of the message, the message including the item of information about the makeup and/or content of the short message; and transmitting to the subscriber a second item of header information and user data, the first item of header information including an item of information about the presence of the second item of header information, and the second item of header Information including at least one item of information about the type of evaluation of the notification message to be performed.

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Art Unit: 2617

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Marcos L Torres
Examiner
Art Unit 2617


mlt


GEORGE ENG
SUPERVISORY PATENT EXAMINER